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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,373	10/29/2003	Gregory Winfield Gorman	412589	6754
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			1794	
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			01/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/696,373

Applicant(s)

GORMAN, GREGORY WINFIELD

Examiner

ALICIA CHEVALIER

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6, 8, 21, 22 and 25-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 5, 6, 8, 21, 22 and 25-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

RESPONSE TO AMENDMENT

1. Claims 1-3, 5, 6, 8, 21, 22 and 25-32 are pending in the application, claims 4, 7, 9-20, 23 and 24 have been cancelled.

REJECTIONS

2. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

3. Claims 1, 5 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Parker (U.S. Patent No. 5,323,652).

Parker discloses a symbol-bearing receptacle for a fluid (*propane tank and indicator, col. 3, lines 9-10*), said receptacle comprising: a container for said fluid (*propane tank, col. 3, lines 9-10*); and a transparent symbol (*col. 3, lines 22-23*) disposed on said container (*figure 1*), the symbol is deemed to have a water reactivity that differs from water reactivity of the container, since they are made of different material, e.g. thermochromic material versus non-thermochromic material; wherein the difference in water reactivities renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point (*col. 3, lines 48-68*). The container comprising an open fluid receptacle formed of a base disposed upon a substrate and a wall affixed to and extending upwardly from said base; and a transparent symbol disposed on said base and facing said substrate (*figure 1 and col. 3, lines 5-10*).

4. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(c) as being anticipated by Arora (U.S. Patent No. 7,048,971).

Arora discloses symbol-bearing (*title*) receptacle (*LCD*) for a fluid (*liquid crystals, col. 12, lines 51-57*), said receptacle comprising a container for said fluid (*col. 12, lines 51-57*); and a transparent symbol (*col. 2, lines 32-37*) disposed on said container, said symbol having a water reactivity that differs from water reactivity of said container (*col. 3, lines 13-42*); wherein the difference in water reactivities renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point (*col. 4, lines 23-26*). The symbol is hydrophilic and said container is hydrophobic or the symbol is hydrophobic and said container is hydrophilic (*col. 3, lines 13-42*). The symbol comprises a plastic silicone film (*col. 5, line 10*).

Claim Rejections - 35 USC § 103

5. Claims 8, 21, 22 and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arora (U.S. Patent No. 7,048,971) in view of Hornsby, Jr (U.S. Patent No. 4,032,687) and Parker (U.S. Patent No. 5,323,652).

Arora is relied upon as described above.

Arora fails to disclose that the symbol is embedded in a surface of the container, the container comprising an open fluid receptacle formed of a base disposed upon a substrate and a wall affixed to and extending upwardly from said base, container comprising a confined passageway, etc.

Hornsby and Parker disclose different types of containers with color changing appliques to indicate the temperature of the different containers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Arora's symbol of different types of containers, i.e. the symbol is embedded in a surface of the container, the container comprising an open fluid receptacle formed of a base disposed upon a substrate and a wall affixed to and extending upwardly from said base, container comprising a confined passageway, etc, that need easy visible references to the temperature of the container.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments the response filed September 26, 2008 regarding the 35 U.S.C. 102(b) rejection over Parker (U.S. Patent No. 5,323,652) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Parker does not disclose "wherein the difference in water reactivities renders the symbol visually distinct from the container when the container holds the fluid and when a temperature of the container is reduced to a condensation point." Specifically Park fails to teach (or even suggest) claim element (b), a transparent symbol having a water reactivity that differs from water reactivity of a container that is disposed upon. Parker entirely fails to disclose (or even suggest) a symbol having a different water reactivity from that of a container.

It is noted that Parker does not explicitly. However, as stated in the office action, the symbol is deemed to have a water reactivity that differs from water reactivity of the container,

since they are made of different material, e.g. thermochromic material versus non-thermochromic material; wherein the difference in water reactivities renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point (*col. 3, lines 48-68*).

Furthermore, the limitation “wherein the difference in water reactivities renders the symbol visually distinct from the container when the container holds the fluid and when a temperature of the container is reduced to a condensation point” is a functional limitation. As defined in the MPEP, “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)” - MPEP § 2173.05(g). However, the examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an *inherent characteristic of the prior art*, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183.

In the instant case, the claimed limitation(s) “wherein the difference in water reactivities renders the symbol visually distinct from the container when the container holds the fluid and when a temperature of the container is reduced to a condensation point” is a functional limitation and is deemed to be an inherent characteristic of the prior art since the prior art is substantially identical in composition and/or structure. The examiner’s sound basis for this assertion is , the

symbol is deemed to have a water reactivity that differs from water reactivity of the container, since they are made of different material, e.g. thermochromic material versus non-thermochromic material; wherein the difference in water reactivities renders said symbol visually distinct from said container when said container holds said fluid and when a temperature of said container is reduced to a condensation point (*col. 3, lines 48-68*).

Applicant further argues that different materials do not necessarily have different water reactivities, and has thus improperly taken Official Notice without submitting any evidence in support thereof. Applicant further states that it is well-known that “thermochromic” relates to color changeability with heat and not to reaction with water. Thermochromicity and water reactivity are not interchangeable.

The examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an *inherent characteristic of the prior art*, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration. Furthermore, Application has not provided any evidence to show that the symbol and container don’t have different water reactivities.

Applicant argues that like claim 1 claim 25 relies upon the difference in container/symbol water reactivities to render the symbol visually distinct from the container.

Applicant's arguments regarding the Parker and the different water reactivities have been addressed above.

Applicant further argues that Parker does not teach an open fluid receptacle, as clearly featured in claims 25.

Parker discloses that the container is a propane tank. While Parker does disclose that the volume of level of propane can be measured without opening the container (*col. 1, lines 13-15*). The tank does have to be opened to release the propane for use and thus is an open fluid receptacle in use.

7. Applicant's arguments the response filed September 26, 2008 regarding the 35 U.S.C. 102(e) rejection over Arora (U.S. Patent No. 7,048,971) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Arora fails to teach (or suggest) that a difference in water reactivities between the symbol and the container renders the symbol visually distinct, and when the container holds a fluid. Applicant further states Arora never discusses a specific relationship between water reactivities of the symbol and the LCD.

Arora discloses that "stimuli also includes a change in temperature inducing condensation of water vapor from air on the hydrophilic coating (*col. 4, lines 23-26*). Therefore, Arora clearly discloses that the difference in water reactivities between the symbol and the container renders the symbol visually distinct. Furthermore, Arora clearly discloses the container holds a fluid, e.g. liquid crystals (*col. 12, lines 51-57*).

8. Applicant's arguments the response filed September 26, 2008 regarding the 35 U.S.C. 103(a) rejection over Arora (U.S. Patent No. 7,048,971) in view of Hornsby, Jr (U.S. Patent No. 4,032,687) and Parker (U.S. Patent No. 5,323,652) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the mere citation to Hornsby and Parker – without indicating what portions of these reference are allegedly relevant to the present claims – claims fails to resolve the clear deficiencies in the base references.

Applicant's arguments regarding the deficiencies of the base references have been addressed above. Furthermore, are used to show Hornsby and Parker disclose different types of containers with color changing appliquéés to indicate the temperature of the different containers.

Applicant further argues that the references fail to disclose different features in claims 25-32. Claim 25, "open container", claim 31 "confined passageway ..." and claim 32, "configured for holding coolant."

As seen in the rejection above, since Hornsby and Parker disclose different types of containers with color changing appliquéés to indicate the temperature of the different containers. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Arora's symbol of different types of containers, i.e. the symbol is embedded in a surface of the container, the container comprising an open fluid receptacle formed of a base disposed upon a substrate and a wall affixed to and extending upwardly from said base, container comprising a confined passageway, etc, that need easy visible references to the temperature of the container. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same

purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” MPEP 2144.06 I. Furthermore, it is an obvious matter of design choice to change the type of container. MPEP 2144.04 (I) and (IV).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Alicia Chevalier/
Primary Examiner, Art Unit 1794
1/22/2009